

PERU

ANSWERS IN THE NAME OF THE PERUVIAN GROUP

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QUESTIONNAIRE ON THE PUBLICATION OF PATENT APPLICATIONS

Questions

Groups are invited to answer the following questions under their national laws:

I. Analysis of current law and case law

1. Please provide a brief description of your law concerning publication of patent applications and identify the statute, rule or other authority that establishes this law.

“Decision 486, Article 40.- Within eighteen months after the filing date in the Member Country concerned or, where priority is claimed, after the date of application, the file shall assume a public nature and shall be open for consultation. The competent national office shall accordingly order the publication of that application in conformity with pertinent domestic provisions. The applicant may request the publication of the application at any time after the examination of its form has been concluded, notwithstanding the stipulation of the previous paragraph. In that case, the competent national office shall order its publication.

Legislative Decree No. 1075, Article 30.- The publication of the abstract of the application shall contain the following information:

- (a) application filing number and date,*
- (b) name and country of the applicant’s address,*
- (c) name of the invention,*
- (d) abstract of the invention,*
- (e) complete data of the claimed priorities.*

The applicant shall carry out the publication in the Official Gazette El Peruano within thirty (30) days from the notification requesting the publication, failing on publication shall involve the abandon of the application.”

In Peru, Article 40 of Decision 486 of the Commission of Andean Community is applied regarding publication term of the patent application, which is 18 months counted from the filing date of the application or from its priority date, as well as the faculty of the applicant to request an earlier publication.

Also, Article 30 of the Legislative Decree No. 1075 is applied, which complements Decision 486 of the Andean Community that sets forth the

Common Regime on Industrial Property, regarding the information of the abstract of the invention to be published, as well as the term of its execution.

2. **Does publication of patent applications occur automatically in your jurisdiction? No. If so, when does publication take place? If not, what are the requirements to effect publication?**

The requirements to effect publication are as follows:

- a) *Number and filing date of the application,*
- b) *Name and country of domicile of the applicant,*
- c) *Title of the invention,*
- d) *Summary of the invention,*
- e) *Full details of the claimed priority or priorities.*

3. **If a patent application claims priority from or the benefit of an earlier application how, if at all, does this affect the timing of publication?**

It affects the timing publication because 18-month term is counted from the oldest claimed priority date; therefore applications claiming the earliest priority date will be published earlier, that is to say, the publication is given in advance to the oldest priority date.

4. **Is there a specific point in time up to which the applicant can withdraw its application without it being published?**

The legislation does not expressly set forth this issue, however if the patent application is withdrawn or if the applicant desists from it before the 18-month term, the patent application will not be published.

5. **What parts of a pending patent application are published?**

The Peruvian Patent Office makes an abstract taking into account the main parts of the specification and claims, then they notify to the applicant with an order letter with the abstract to be published in the Official Gazette. The abstract prepared by the Patent Office is not necessarily equal to the abstract of the application (as verified in several files).

6. **Does a published pending patent application give rise to provisional rights (or any type of interim protection) in your jurisdiction and, if so, to what extent?**

Expectant rights are obtained from the application filing date, by virtue of the precedence and/or priority. With regard to precedence, Article 12 of the Legislative Decree No. 1075 assumes the good faith in favor of the first applicant however it is not recognized if bad faith is demonstrated. Other right is the claimed priority date that can be claimed taking into account the filing date of the patent application in Peru, within 12 months of filing the first

application in other country. The application that enjoys priority right has precedence over any other patent application for the same invention.

- 7. Does an unpublished pending patent application give rise to provisional rights (or any type of interim protection) in your jurisdiction and, if so, to what extent?**

Expectant rights are obtained from the application filing date, by virtue of the precedence and/or priority.

- 8. Is 'early publication' allowed in your jurisdiction?**

Yes, at the express request of the applicant.

If so, what are the conditions for such early publication?

1) That the applicant request is made by a writ,

2) That formal examination has ended.

How is the request for early publication made?

By means of a single writ.

What is the effect of an early publication on a pending patent application?

The effect is the knowledge prior to 18 months by thirds.

- 9. Is non-publication possible in your jurisdiction?**

It is not possible the non-publication in our jurisdiction.

In other words, can a pending patent application remain confidential?

It is not possible, unless the Applicant desists from the application prior to 18 months.

If so, under what conditions is such allowed? How is the request for non-publication made?

It is not a matter of an explicit request, but rather a formal withdrawal.

- 10. Will a lapsed, abandoned or withdrawn patent application be published? If not, is that automatic or by the request of the applicant? If it would otherwise be published, can the applicant request non-publication?**

If a patent application is lapsed, abandoned or withdrawn before the ending of the 18-month term, the patent application will not be published. On the contrary, if the application is lapsed, abandoned or withdrawn after the 18-month term, the application will be published.

- 11. What is the position in your jurisdiction regarding the publication of continuation, continuation-in-part and divisional applications?**

There are not any continuation applications or continuation-in-part applications. Only divisional applications are allowed in our country. Divisional applications are published once the formal examination has finished. Bear in mind that divisional applications are prosecuted in separate applications, these divisional applications only receive the benefit of the priority claim from the parent application.

II. Policy considerations and proposals for improvements to your current system

12. Should there be a requirement for automatic publication of pending applications by a particular deadline?

Yes, there should be an automatic publication for PCT national phases once finalized the stage of Formal Examination. The deadline should be within the month after the ending of the formal examination. It is necessary to bear in mind that PCT national phases are already published by International Bureau during the international phase.

In National applications that are not filed via PCT, the automatic publication must be considered once lapsed the 18-month term.

13. Should there be a right for the patentee to request early publication? If so, on what basis and with what consequence?

In our regulation, there is a rule that allows applicants to request early publication, since early publication is a regulation element that applicants may use or not according to its needs. In our patent system, the early publication does not expedite the patent prosecution.

14. If your answer to question 13 is yes, should all the applications deriving from the same priority application be subject to the early publication if one application is published early?

Not necessarily.

15. Should there be a right for the patentee to withdraw the application before publication?

In our regulation, article 12 of Decision 486 authorizes applicants to withdraw their patent applications at any time during patent prosecution: the withdrawal of an application for a patent or registration shall put an end to the administrative proceedings as from the declaration by the competent national office, with loss of the filing date assigned to the application.

If the withdrawal is filed before the application is published, it shall not be published. In the case of applications for patents for invention, such applications shall be held in abeyance and may not be consulted without the written consent of the applicant except where the period of 18 months has lapsed.

16. If your answer to question 15 is yes, what should be the consequence of such withdrawal:

a. with respect to the patentee's own subsequent patent applications;

If the withdrawal is before publication, subsequent applications should not be affected by the withdrawal application, provided that the subject matter of the withdrawal application was not published by other means, e.g. scientific journals.

b. with respect to third party patent applications?

The applicant, who withdraws its application before publication, shall lose its precedence rights along with the fact of that content of withdrawal application shall not affect the third party patent applications.

- 17. If your answer to question 15 is yes, should the patent office be required to provide its initial assessment of the validity of the patent (if granted) before the applicant is required to decide whether to withdraw?**

In our patent system, it is not allowed to require an initial assessment since this will delay the publication of the patent application. However, we consider that the patent office should be required to provide an initial assessment in order to benefit the applicants. This according to the current practice in the international phase of PCT application, where a preliminary assessment is issued by International Search Authority or International Preliminary report Authority.

- 18. In light of your answers to the previous policy questions, what would be appropriate time limits for:**

a. the patent office to provide the results of its initial assessment?;

Before the 16-month term counted from the earliest priority date or the filing date of application without claiming priority,

b. the applicant to decide whether to withdraw the application?

Before the 18-month term for ordering the national publication.

and

c. the application to be published?

Once lapsed the 18-month term.

- 19. Should there be any exceptions to automatic publication, and if so what on what grounds, for example:**

a. on the initiative of the patentee;

If the application is withdrawn before the 18-month term.

b. on the initiative of the patent office;

If the application is opposed to the public order or the national security.

or

c. on the initiative of third parties (such as other governmental agencies)?

No, there should not be any exceptions to automatic publications.

20. If your answer to question 19 is yes, who should decide on whether such exception is applied?

The decision regarding the exceptions should be decided by the Patent Office.

21. Should there be different rules for the publication of continuation, continuation-in-part and divisional applications?

No, the same rules should be applied for publication of continuation, continuation-in-part and divisional applications.

22. What proposals would you make to improve your current system?

Publications should contain the entire application comprising the specification, claims, abstract, and drawings.

Once granted the application, there should be a publication of the entire patent comprising the amended pages and the granted claims.

Instead of the publication in the National Gazette, the publication should be performed in an electronic repository located in the website of the Patent Office.

III. Proposals for harmonization

Groups are invited to put forward proposals for the adoption of harmonized rules in relation to the publication of patent applications. More specifically, the Groups are invited to answer the following questions:

23. Should patent offices be required to provide examination results or at least search results prior to publication so that applicants can make an informed decision whether to pursue obtaining a patent or to withdraw the application and protect the invention idea as a trade secret?

Patent Offices should provide a preliminary examination or at least search results prior to the publication so that applicants can take an informed decision of pursuing or not with patent application.

24. Should there be any exception to publication of applications, for example by the applicant's opt-out?

If applicants withdraw an application before the publication, said application must remain confidential. Other considerations or exceptions should be informed by patent offices to the application under transparency principle.

25. How should exceptional circumstances be defined, e.g., public order, morality or national security where the patent office delays or suppresses publication?

Exceptional circumstances should be established by the patent offices, these circumstances should take into account the pertinent national legislation. Thereafter, the patent offices should communicate these exceptional circumstances to the applicant.

To what extent should these exceptional circumstances be specifically defined?

The extent should be defined by the patent offices. Likewise, the patent offices should give the opportunity to the applicant to argue against these exceptional circumstances.

26. **What is an appropriate period for publication after filing an application or after the priority date? Is 18 months an appropriate period?**

An appropriate period for publication should be counted from the priority date; we consider that 18 months are an appropriate period.

27. **Please make any other comments or proposals for harmonization in relation to publication of patent applications that you consider appropriate.**

Patent offices should publish the entire content of the applications, i.e. publications should contain the specification, claims, abstract and figures. The number identifying the publications (publication number) should be harmonized to all jurisdictions in order to expedite patent searches.